Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 8

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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	**CAUSE NO. A O5 CA 334 SS**
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

REPLY BRIEF IN SUPPORT OF
PLANTIFFS' MOTION FOR PARTIAL SUMMARY JUDGMENT

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I. INTRODUCTION

This case arises from a classic blunder in patent law. An unsupervised junior attorney amended the claims of Immunocept's patent to insert the phrase "consisting of" (where a competent patent attorney, aware of the enormous difference in meaning, would have used "comprising") thus shrinking the scope of the patent and slashing its commercial value. In the co-pending *Markman* motion, Immunocept asks the Court to confirm that effect by construing claim 1 to cover a method for treating of toxic-mediator related diseases (e.g. sepsis and septic shock) having only a single step.

If the Court adopts Immunocept's claim construction, then partial summary judgment is appropriate because: 1) several methods for treating sepsis and septic shock exist, and 2) such methods, in combination with the recited Large Pore Hemofiltration step, lie outside the '418 patent as construed. Ruling on this partial summary judgment motion will resolve a critical issue because the parties vigorously disagree on whether Fulbright's botched prosecution substantially diminished the scope and thus the value of the '418 patent.

In response, Fulbright fails to identify any disputed facts. Instead, it argues that: 1) any ruling by this Court would be an impermissible advisory opinion, and 2) if the Court chooses to rule, Fulbright needs more time for discovery. Neither argument withstands a close look.

First, a decision must ultimately be made in this case as to whether infringement is avoidable by adding the specific treatment steps cited in this motion. The reduction in value of the patent, the core dispute of the case, cannot be resolved without knowledge of what coverage was sacrificed by Fulbright's ineptitude. There is nothing "advisory" about the role of that decision because it is pivotal to the final outcome of this suit. Whether decided by Court or jury, the decision simply cannot be ducked. Since the decision is amenable to summary judgment, it should be resolved now.

Second, no further discovery is necessary because Fulbright has had ample time to take discovery and has done so through numerous lay and expert depositions. Fulbright should not be heard to cry surprise on an issue squarely presented by the Complaint and pursued by both parties during the normal discovery period. Fulbright's disingenuous Rule 56(f) declaration is simply one more attempt to postpone a trial on the merits.

II. FACTUAL BACKGROUND

Amazingly, Fulbright complains it had no notice of the issues raised in the pending motions because Immunocept "never pleaded infringement of the '418 patent". 56(f) Decl. at ¶ 4. Of course, Immunocept did not plead infringement because it does not contend that there is infringement. To the contrary, as Fulbright well knows, Immunocept has pled and argued that the '418 has been drafted so narrowly that copy cats can easily *avoid* infringement.

> J&J lawyers believed the patent attorneys at Fulbright and Jaworski had drafted the patent so that it provided no real protection from copy-cat devices and methods. In the opinion of the J&J lawyers, others would *effectively be able to copy the device and method* without infringing upon the Plaintiff's patent. Complaint at ¶ 17, Exh. A, (emphasis added).

This motion will establish how easily a competitor can copy Immunocept's patented method without infringing the '418 patent, an issue that has been the subject of discovery by both parties. Indeed, Fulbright's attorney, Mr. Gannaway, asked Immunocept's patent expert:

> What steps do you think could be added to the invention described in the '418 that would permit a competitor to practice the technology without infringing? MacPherson Dep. at 85:5-12, Exh. B.

That question clearly demonstrates Fulbright's long-standing awareness of the issues raised in this motion. Indeed, Fulbright's patent expert report addresses the same point when discussing "the value of the '418 patent." The report states that "minor or peripheral additions to the filter such as controls, gauges, valves etc. would not in my opinion serve to avoid infringement of the method claim." (Kirk Report at ¶14 attached as Exh. C). Thus, the record belies Fulbright's attempt to cry surprise. The scope of the '418 patent has been at issue from the commencement of this lawsuit.

III LEGAL ANALYSIS

A. Summary Judgment Is Appropriate Under Rule 56.

Fulbright argues that summary judgment is not appropriate because this is not an infringement case. Yet the scope of the '418 patent is a disputed issue central to Immunocept's well-pled malpractice claim. Fed. R. Civ. P. 56(a) states that a claimant may move for "summary judgment in the party's favor upon all or any part thereof." The Advisory Committee's Notes state that this provision "permits summary determination of an 'issue substantially affecting but not wholly dispositive' of a claim or defense." Here, a summary ruling on non-infringement will substantially advance Immunocept's claim for damages because it will confirm how narrowly Fulbright drafted the '418 patent. Therefore, partial summary judgment on non-infringement can be granted. Indeed, in patent cases, courts regularly rule on non-infringement summary judgment motions. *See e.g. Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1350 (Fed. Cir. 2001) ("The court's construction of the claims often decides the question of infringement, whether literal infringement or under the doctrine of equivalents."(citation omitted)); *Goldenberg v. Cytogen*, Inc., 373 F.3d 1158, 1163 (Fed. Cir. 2004) ("Summary judgment on the issue of literal infringement is proper 'when no genuine issue of material fact exists . . ..'' (citations omitted)).

B. There is Legitimate Case or Controversy

Fulbright also desperately tries to avoid the merits by arguing that this Court does not have jurisdiction to interpret to rule on summary judgment because there is no Article III "case or controversy." The *Laitram* decision that Fulbright relies upon relates only to declaratory judgment jurisdiction over patentees and arms-length competitors, not to disputes between a patentee and its own patent counsel. Here, Immunocept's complaint describes Fulbright's malpractice and that issue is clearly in controversy for Article III purposes.

C. The Key Facts Remain Undisputed.

Fulbright's arguments on the merits are conspicuous by their absence. Fulbright offers no alternative to Immunocept's claim construction (addressed separately in Immunocept's *Markman* Reply Brief), remaining content merely to criticize it and ask that it not be done at all. Likewise, Fulbright does not challenge the factual basis for Immunocept's summary judgment motion. First, Fulbright does not, because it cannot, argue that the seven identified treatments for sepsis *exist* (the virtues and weaknesses of those therapies are not relevant to this motion). Second, if the Court adopts Immunocept's claim construction, Fulbright does not argue that the multi-step therapies infringe the '418 patent (thus implicitly conceding Immunocept's point). Accordingly, if this Court adopts Immunocept's proposed claim construction, summary judgment is appropriate.

D. Fulbright's Rule 56(f) Affadavit Is Insufficient

Fulbright's Rule 56(f) affadvait is insufficient for two reasons. First, the affidavit fails to explain why Fulbright did not take the discovery it seeks earlier. As discussed above, Fulbright had ample notice that Immunocept alleged that the '418 patent was so narrow that it did not protect Immunocept against copy cat competition. Moreover, this case is currently scheduled for trial in April and the discovery cut-off date was February 13, 2006 (some depositions were taken after that deadline). Thus, there is no reason to extend discovery at this late date. Second, Fulbright has taken ample discovery including: 1) exchanging expert reports; 2) deposing coinventors, Dr. Lee and Dr. Matson; 3) deposing medical expert Dr. Bellomo; 4) deposing patent expert Mr. MacPherson; and 5) offering testimony from its own two medical experts and patent expert. The Advisory Committee Note on Rule 56(f) states:

> A request should be presented by an affidavit which, under the revised rule, must reflect good cause for the inability to comply with the stated time requirements.

Here, Fulbright has failed to show good cause. It has had notice of the issues raised in the summary judgment motion, had ample time to take discovery on those issues, and has actually taken discovery on those issues.

IV. CONCLUSION

Summary judgment may be avoided only by showing that a genuine issue of material fact intervenes, or that no discovery opportunity has been afforded that would permit such a showing to be made. Fulbright has pointed to no genuine issue of fact, and has made absolutely no showing that would excuse its failure to take discovery in the normal course of pre-trial litigation.

Immunocept's motion presents an issue critical to the resolution of this case that is ripe for summary adjudication.

Respectfully submitted,

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CERTIFICATE OF SERVICE

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